REMARKS/ARGUMENTS

Claims 1-24 are pending in this application. Claims 1, 15, 20 and 21 have been amended, and claim 3 is canceled. These amendments are made without prejudice to presentation of the original claims in a continuing application.

As a preliminary matter, Applicants provide a review of the patents and patent applications that claim priority of the patent application from which the instant application derives:

> The instant application (Attorney Docket No. VTN-572) was filed on January 17, 2002 as a continuation of Serial No. 09/420,569 (Attorney Docket No. VTN-476).
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> Serial No. 10/372,463 (Attorney Docket No. VTN-476-USA-DIV1), which is currently pending, was filed on February 24, 2003 as a divisional of Serial No. 09/420,569 (Attorney Docket No. VTN-476).
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> Serial No. 09/420,569 (Attorney Docket No. VTN-476), which issued on April 15, 2003 as U.S. Pat. No. 6,548,818, was filed on October 19, 1999 as a continuation-in-part of Serial No. 09/187,579 (Attorney Docket No. VTN-423).
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> Serial No. 09/818,725 (Attorney Docket No. VTN-564), which is currently pending, was filed on January 29, 2003 as a continuation of Serial No. 09/187,579 (Attorney Docket No. VTN-423).
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> Serial No. 09/187,579 (Attorney Docket No. VTN-423), which issued as U.S. Pat. No. 6,246,062 B1 on June 12, 2001, was filed on November 5, 1998.

The specification on page 1 has been amended to update the cross reference to related applications and to correct a typographical error. The specification has also been amended so that the word "calorimeter" found in the paragraph on page 6, line 11 reads "**co**lorimeter". Applicants regret that this typographical error evaded editorial review of the specification upon filing. Applicants believe that one skilled in the art would readily recognize this

typographical error because colorimeters (like the corresponding disclosure of spectrometers, photodiodes, and photosensors) detect electromagnetic radiation for analyzing optical properties, whereas calorimeters detect heat for analyzing thermodynamic properties.

I. "Same Type" Doubling Patenting Rejections under 35 U.S.C. § 101

Claims 1, 2, 4, 6, 7, 10, 11, 12, 13, 14, 15, 21, 22, 23 and 24 stand rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1, 2, 3, 4, 5, 8, 9, 10, 11, 12, 15, 22, 23, 24 and 19, respectively, of prior U.S. Patent No. 6,246,062 (the "062 patent"). Although Applicants do not necessarily concur, they have amended independent claim 1 to an apparatus capable of detecting the presence or position of an ophthalmic product in a container sealed with a lidstock. Claims 2, 4, 6, 7 and 10-15 depend on claim 1 and include these limitations too. Method claim 21 and the claims that depend from it similarly recite use of a container sealed with a lidstock.

Claim 20 stands rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claim 19 of prior U.S. Patent No. 6,548,818 (the "818 patent"). Although Applicants do not necessarily concur, they have amended claim 20 to an apparatus capable of detecting the presence or position of an ophthalmic product in a container sealed with a lidstock, the apparatus comprising a detector that is disposed relative to the sealed container and the source to detect electromagnetic energy from the source which is reflected by a reflective surface.

Since the pending claims clearly are of a different scope than those recited in the 062 patent or the 818 patent, the rejections under 35 U.S.C. § 101 are believed to be moot.

II. "Obviousness Type" Doubling Patenting Rejections

Claims 5, 8-9, 16-17 and 18-19 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-2, 4, 7, 12 and 15-16 of the 062 patent. Applicants respectfully traverse this rejection because the Office Action fails to establish a *prima facie* case of obviousness. The Federal Circuit has held that the Examiner's showing of obviousness for obviousness-type double patenting rejection must follow the analysis used to establish a *prima facie* case of obviousness. *In re Longi*, 225 USPQ 645, 651 (Fed. Cir. 1985). "Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection," the MPEP mandates that "the factual inquiries set forth in *Graham v. John Deere, Co.* 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 [be] employed when making an obviousness-type double patent analysis." MPEP § 804. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2143, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action, however, does not provide any analysis of the *Graham* factors or otherwise make out a *prima facie* case of obviousness. Rather, the Office Action merely

asserts that the specific recitation of the various elements of the instant claims are well known as functionally equivalent and/or otherwise routine variations, alternative arrangements, or optimal design choices that are typical for optical analysis systems:

> "Although the conflicting claims are not identical, they are not patentably distinct from each other because: the specific recitation that a reflective element is integral with the container (claim 3); the specific recitation of the source as being a pulsed source (claim 5); the specific recitation that the processor includes the use of a lookup table or neural network (claims 8-9); the specific recitation that the detector is a spectrometer including a filter (claims 16-17); and the specific identification of a plurality of detectors as including a specific range of 1-100 detectors or 1-20 detectors (claims 18-19) **are well known as functionally equivalent and/or otherwise routine variations, alternative arrangements, or optimal design choices that are typical for optical analysis systems,** and therefore do not define any patentable distinction between the claims as recited and those of the U.S. patent."

(Office Action at page 3, emphasis supplied).

This allegation fails to establish a *prima facie* case of obviousness for at least four reasons:

(1) the Office Action does not explain why one of ordinary skill in the art would have had a reasonable expectation of success of arriving at the pulsed source limitation of claim 5, and further in view of the sealed container and reflective foil lidstock limitations of independent claim 1;

(2) the Office Action does not explain why those of ordinary skill would have had a reasonable expectation of success of arriving at the use of a lookup table or neural network with the processor of claims 8-9;

(3) the Office Action does not explain why those of ordinary skill would have had a reasonable expectation of success of arriving at the detector

being a spectrometer or the detector including the filter limitation of claims 16-17 ; and

(4) the Office Action does not explain why those of ordinary skill would have a reasonable expectation of success of arriving at the plurality of detectors limitation as including a specific range of 1-100 detectors or 1-20 detectors limitations of claims 18-19.

Absent such explanations (together with evidence supporting them), the rejections for alleged obviousness-type double patenting lack adequate support. Support is also lacking for the Examiner's assertion that certain claim limitations would have been "well known," there are no publications or other supporting evidence of record. Applicants request that any such evidence known to the Examiner be made of record, or that the rejection be withdrawn.

Applicants also traverse this rejection because it would not have been obvious to one of ordinary skill to modify the subject matter recited in the 062 patent claims in a way that would have produced the instantly-claimed inventions. For example, the Office Action fails to identify any claim of the 062 patent that teaches or suggests an apparatus that detects the presence or position of an ophthalmic product in a container sealed with a lidstock comprising a reflective foil, or one in which a non-imaging detector is disposed relative to the container and the source to detect electromagnetic energy from the source which is reflected by the container. Since such a teaching or suggestion is required to establish a *prima facie* case of obviousness, Applicants respectfully request that this rejection be withdrawn.

III. Alleged Issue of Priority

The Office Action asserts that an issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) must be resolved because claims 1, 2, 4, 6, 7, 10, 11, 12, 13, 14, 15, 21, 22, 23 and 24 are allegedly directed to the same invention as that of claims 1, 2, 3, 4, 5, 8, 9, 10, 11, 12, 15, 22, 23, 24 and 19, respectively, of commonly-assigned 062 patent. Applicants have amended the instant claims, and there is no conflict between the instant application and the 062 patent.

IV. Conclusions

Applicants request the Examiner to:

(1) enter the amendments to the specification and to claims 1, 15, 20 and 21, and cancel claim 3;

(3) reconsider and withdraw the standing rejections of the claims; and

(4) pass claims 1-2 and 2-24 to allowance.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-5984.

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